Application No. 10/035,783

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Attorney Docket No.: 1016US

CERTIFICATE OF MAILING

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Debra K. Bowen

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Graupe, et al.

Application No.: 10/035,783 Group Art Unit: 1626

Filed: 12/24/01 Examiner: Shiao, R.

Title: NOVEL COMPOUNDS AND COMPOSITIONS AS

CATHEPSIN INHIBITORS

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

RESPONSE

This reply is filed in response to an Office Action mailed June 11, 2003, for which a response is due on September 11, 2003. Enclosed under separate cover is a Petition from Requirement for Restriction under 37 C.F.R. § 1.144 (2003). Applicants herein request cancellation of Claim 30 and reconsideration of the Requirement for Restriction.

PROCEDURAL HISTORY

In an Office Action mailed November 6, 2002, the Examiner required the Applicants to elect one of the following three groups:

I. Claims 8-9, 13-15 and 1-7, in part, drawn to compounds, Claim 28, in part, drawn to compositions, Claims 29-30, in part, drawn to methods of treatment, and Claim 31, in

part, drawn to methods of making; Class 558, subclass various, wherein X^1 , R^3 and R^4 are non-heterocyclic.

- II. Claims 10-12, 16-18, 19-21, 22-24 and 1-7, in part, drawn to compounds, Claim 28, in part, drawn to compositions, Claims 29-30, in part, drawn to methods of treatment, and Claim 31, in part, drawn to methods of making; Class 544-558, subclass various, wherein X¹, R³ and R⁴ are heterocyclic.
- III. Claims 25-27 and 1-7, in part, drawn to compounds, Claim 28, in part, drawn to compositions, Claims 29-30, in part, drawn to methods of treatment, and Claim 31, in part, drawn to methods of making; Class 544-558, subclass various, wherein X¹, R³ and R⁴ are heterocyclic.
- IV. Claims 1-7, in part, drawn to compounds, Claim 28, in part, drawn to compositions, Claims 29-30, in part, drawn to methods of treatment, and Claim 31, in part, drawn to methods of making; Class 544-558, subclass various, wherein X¹, R³ and R⁴ comprise compounds not encompassed by Groups I, II or III.

The Applicants further were required to elect a single disclosed species for examination. In a response dated May 5, 2003 the Applicants elected Group II and the species disclosed on page 546, line 9 and 10, of the specification having the following structure:

$$\begin{array}{c|c}
F & O \\
F & O \\
S = O \\
N & N - N
\end{array}$$